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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,710	07/15/2002	Gracme Deaker	TJK/216	3993
27717 7590 12/01/2009 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803				
EXAMINER AGWUMEZIE, CHARLES C				
ART UNIT 3685		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,710

Applicant(s)

DEAKER ET AL.

Examiner

CHARLES C. AGWUMEZIE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-96 is/are rejected.
- 7) ☒ Claim(s) 93 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1448 or PTO-889)
Paper No(s)/Mail Date 02/27/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 6, 2009 has been entered.

Acknowledgments

2. Applicants' amendment filed on October 6, 2009 is acknowledged. Accordingly claims 79-92 and 94-97 remain pending.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 94 been renumbered 93 and claims 95-97 renumbered claims 94-96.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 79, 89, 90,** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner has reviewed the specification and has not been able to find in any part within the specification that would support the phrase "used/unused status". Clarification and correction is required.
- Claims 80-88, 91-96 as renumbered are similarly rejected by virtue of their dependency from claims 79 and 90.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 79-82, and 86-87, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106

8. As per claims 79, and 89, Walker et al discloses a payment method comprising:
receiving an order from a customer for a prepaid voucher (see fig. 7A, *which discloses receive request to purchase gift code and amount of money to be credited to gift code record step 126*);

receiving payment from said customer for said prepaid voucher via a computer network (see fig. 7B, *which discloses transmit credit card number and amount of money to be credited to transaction processing network/credit card processor for gift code authorization*);

generating said prepaid voucher in response to receiving said order and said payment (see fig. 7A, *which discloses generate gift code step 128; store requested value in gift code record step 130*);

generating a token associated with said prepaid voucher (see fig. 7A, *which discloses generate gift code step 128; generate and transmit ID code to buyer step 122*);

associating said token with said prepaid voucher in a database (see fig. 7B, *which discloses flag gift certificate record as prepaid and store authorization code step 144*);

indicating an unused status of said prepaid voucher in said database (see fig. 9, *which discloses is status filed or pending? Step 216*; col. 11, lines

30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*);

receiving a request for validation of said prepaid voucher from a redemption point, said request including said token (col. 8, lines 40-55, *which discloses the process starting (step 162) with central controller 12 receiving a gift certificate code (step 163) via a transmission from a redeemer operating the buyer/redeemer interface 16 via the Internet*); and

confirming said unused status by said database with a query including said token (col. 11, lines 30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*).

What Walker does not explicitly use is the claim phrase unused status. However Walker teaches whether the gift certificate has been redeemed or not redeem. A person of ordinary skill in the art would recognize that unused voucher is equivalent to an

unredeemed certificate. Accordingly it would have been obvious to one of ordinary skill in the art to substitute unredeemed status with the claimed unused status.

9. As per **claim 80**, Walker further discloses the payment method, further comprising:

providing a validation of said prepaid voucher to said redemption point in response to confirming said unused status (col. 8, lines 40-55; col. 11, lines 30-45).

10. As per **claim 81**, Walker further discloses the method, further comprising:

receiving a notification of use of said voucher from said redemption point in response to providing said validation (col. 11, lines 30-45); and

indicating a used status of said prepaid voucher in said database in response to receiving said notification of use (col. 11, lines 30-45).

11. As per **claim 82**, Walker further discloses the method, further comprising:

said order being received from said customer via the a computer network (col. 8, lines 40-55).

12. As per **claim 83**, Walker further discloses the method, further comprising:

said order specifying a selected one of a plurality of subscriber retailers (col. 11, lines 50-60).

13. As per claim 86, Walker further discloses the method, further comprising:
delivering said prepaid voucher to a recipient via postal service (col. 8, lines 10-25).

14. As per claim 87, Walker further discloses the method, further comprising:
delivering said prepaid voucher to said recipient via electronic mail (fig. 7A).

15. Claims 84, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106 in view of Robertson U.S. Patent Application Publication No. 2005/0197919 A1.

16. As per claim 84, Walker failed to explicitly disclose the method, further comprising:

said pre-paid voucher including voucher information identifying a selected subscriber of a plurality of subscriber retailers.

Robertson discloses the method, further comprising:

said pre-paid voucher including voucher information identifying a selected subscriber of a plurality of subscriber retailers (see fig. 2).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said pre-paid voucher including voucher information identifying a selected

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subscriber of a plurality of subscriber retailers in view of the teachings of Robertson in order to ensure security

17. Claims 85, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106 in view of Scroggle et al (hereinafter "Scroggle") U.S. Patent No. 6,014,634.

18. As per claim 85, Walker failed to explicitly disclose the method, wherein said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber.

Scroggle discloses the method, wherein said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber (see fig. 11)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method comprising said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber in view of the teachings of Scroggle in order to ensure security

19. Claims 88, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106 in view of Beach et al (hereinafter "Beach") U.S. Patent Application Publication No. 2002/0069104.

20. As per **claim 88**, Walker failed to explicitly disclose the method, wherein said token comprises a randomly generated token.

Beach discloses disclose the method, wherein said token comprises a randomly generated token (see abstract; 0012; 0015).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method wherein said token comprises a randomly generated token in view of the teachings of Beach in order to ensure security

21. **Claims 90-93, and 96**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson U.S. Patent Application Publication No. 2005/0197919 A1 in view of Walker et al U.S. Patent No. 6,138,106.

22. As per **claim 90**, Robertson discloses an electronic commerce payment system comprising:

a computer network in communication with at least one database storing a list of subscriber retailers (see fig. 9, *which discloses more active merchants step 252; 0010, which discloses allowing gift recipients to use a digital gift certificate in lieu of payment at a plurality of participating merchants*);

a website in communication with said network, said website configured to receive a customer order for a voucher from at least one of a plurality of subscribing retailers and to receive payment from said customer for said voucher (see fig. 3, *which discloses visitor locates gift certificate site step 100; user chooses to purchase a gift certificate step 124*);

said website in communication at said at least one database storing a list of said subscribing retailers (see fig. 1, *which discloses merchant database step 92*);

said website configured to cause generation of said Voucher in response to said payment, and storage of information descriptive of said voucher in association with a token in said at least one database (see fig. 3, *which discloses create new record in gift certificate database step 136*);

said at least one database including a used/unused status indicator associated with said token; and

a redemption system configured to communicate said used unused status to a subscribing retailer in said list of subscribing retailers in response to an inquiry from said subscribing retailer, said inquiry including said token.

23. What Robertson does not explicitly teach is:

said at least one database including a used/unused status indicator associated with said token; and

a redemption system configured to communicate said used unused status to a subscribing retailer in said list of subscribing retailers in response to an inquiry from said subscribing retailer, said inquiry including said token.

24. Walker discloses:

said at least one database including a used/unused status indicator associated with said token (see fig. 9, *which discloses is status filed or pending? Step 216; col. 11, lines 30-45, which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*); and

a redemption system configured to communicate said used unused status to a subscribing retailer in said list of subscribing retailers in response to an inquiry from said subscribing retailer, said inquiry including said token (see fig. 9, *which discloses is status filed or pending? Step 216; col. 11, lines 30-45, which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Robertson and incorporate a system comprising said at least one database including a used/unused status indicator associated with said token; and a redemption system configured to communicate said used unused status to a subscribing retailer in said list of subscribing retailers in response to an inquiry from said subscribing retailer, said inquiry including said token in view of the teachings of Walker in order to ensure security of the certificate by ensuring that only unused certificates are eligible for redemption.

25. As per claim 91, Robertson failed to explicitly disclose the system, further comprising:

said redemption system configured to cause said used/unused status to indicate use of said voucher in response to said inquiry.

Walker discloses the system, further comprising:

said redemption system configured to cause said used/unused status to indicate use of said voucher in response to said inquiry (col. 11, lines 30-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Robertson and incorporate a system comprising said redemption system configured to cause said used/unused status to indicate use of said voucher in response to said inquiry in view of the teachings of Walker in order to ensure security of the certificate by ensuring that only unused certificates are eligible for redemption.

26. As per **claim 92**, Robertson failed to explicitly disclose the system, further comprising:

said inquiry descriptive of a partial use of said voucher; and

said redemption system configured to cause said used/unused status to indicate said partial use of said voucher in response to said inquiry.

Walker discloses the system, further comprising:

said inquiry descriptive of a partial use of said voucher (see fig. 5); and

said redemption system configured to cause said used/unused status .to indicate said partial use of said voucher in response to said inquiry (see fig. 5).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Robertson and incorporate a system comprising said inquiry descriptive of a partial use of said voucher; and said redemption system configured to cause said used/unused status to indicate said partial use of said voucher in response to said inquiry in view of the teachings of Walker in order to ensure security of the certificate by ensuring that only unused certificates are eligible for redemption.

27. As per **claim 93**, Robertson further discloses the system, further comprising:

a payment system in communication with said network, said payment system configured to approve said payment (see fig. 4).

28. Claims 94-96, as renumbered are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson U.S. Patent Application Publication No. 2005/0197919 A1 in view of Walker et al U.S. Patent No. 6,138,106 and further in view of Scroggle et al (hereinafter "Scroggle") U.S. Patent No. 6,014,634.

29. As per claim 94, Robertson and Walker failed to explicitly disclose the system, further comprising:

said at least one database including voucher image data for said voucher; and
said website configured to cause generation of a voucher image associated with said voucher in accordance with said voucher image data.

Scroggle discloses the system, further comprising:

said at least one database including voucher image data for said voucher; and
said website configured to cause generation of a voucher image associated with said voucher in accordance with said voucher image data (see fig. 11; see abstract; col. 2, lines 55-65)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said at least one database including voucher image data for said voucher; and said website configured to cause generation of a voucher image associated with said voucher in accordance with said voucher image data in view of the teachings of Scroggle in order to ensure security

30. As per claim 95, both Robertson and Walker failed to explicitly disclose the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers.

Scroggle discloses the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers (see fig. 11; col. 10, lines 25-60; col. 11, lines 10-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said voucher image is associated with each of said plurality of subscribing retailers in view of the teachings of Scroggle in order to ensure security

31. As per claim 96, Robertson further discloses the system, further comprising:

said website configured to receive a beneficiary designation for said voucher from said customer and to cause delivery Of Said voucher to said beneficiary (0044; 0169; 0180).

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
November 25, 2009